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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,964	09/12/2003	Steven H. Shepherd	200-81	6343
30448	7590	01/14/2005	EXAMINER	
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/660,964	<b>Applicant(s)</b> SHEPHERD, STEVEN H.	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/13/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

Claim Numbering

1. It is noted that on page 18 through 19 the numbering of the claims is not consecutive, i.e. there are two claims numbered 16-18. The Examiner has renumbered the claims starting with the second numbered claim 16 to be claims 19-28. In the future these claims should be referred to as such.

***Claim Rejections - 35 USC § 112***

2. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 appears to repeat a limitation previously claimed in claim 1 from which it depends and therefore it is not clear what structural limitations applicant intends to encompass with such language.

Claim 20 contradicts the limitation of claim 1, i.e. a smooth outer surface, rendering the claim confusing, vague, and indefinite.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 7-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatti (3703775) in view of Stone (4377913) and Hayashi (3583081).

Gatti shows a shoe comprising an upper and sole with an inner tongue portion (11), outer padded tongue portion (4), a fastening structure (lace and eyelets at 17), and an engagement structure (16) substantially as claimed except for the sole bottom being smooth, the upper being formed from closed cell foam and the exact engagement structure. Hayashi teaches providing padding (22) throughout the entire upper and teaches providing a smooth sole (92, figure 1). Stone teaches the use of hook and loop fasteners on the underside of an outer tongue portion for an engagement structure. It would have been obvious to provide padding in the upper and to provide a smooth sole as shown and taught by Hayashi and to provide the hook and loop engagement structure taught by Stone in the shoe of Gatti to increase comfort, to make the shoe usable on artificial turf or hard surfaces, and to make the outer tongue easier and faster to attach.

In reference to claims 4, and 9-15, Gatti as modified above discloses the claimed invention except for the exact materials for the padding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam with the properties as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claims 16-18, Gatti as modified above discloses the claimed invention except for the exact thickness for the padding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the padding of the thickness in the ranges claimed, since it has been held that where the general

conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to claims 20-22, Stone teaches a sole which is patterned and chamfered. It would have been obvious to pattern and chamfer the sole as taught by Stone in the shoe of Gatti as modified above to increase traction and stability.

In reference to claims 23 and 24, Gatti as modified above discloses the claimed invention except for the exact materials for the sole. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an EVA with the durometer as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claim 28, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Sass (3650051).

Gatti as modified above shows a shoe substantially as claimed except for the exact location of the attachment of the outer tongue. Sass teaches attaching an outer tongue on the side of the shoe. It would have been obvious to attach the outer tongue portion on the side as taught by Sass in the shoe of Gatti as modified above to provide a more secure permanent attachment of the outer tongue portion.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Dassler (3284931).

Gatti as modified above shows a shoe substantially as claimed except for padding material in the inner tongue portion. Dassler teaches providing padding on a conventional inner tongue portion which is located between the wearers foot and the laces (note column 2 lines 1-45). It would have been obvious to provide padding on the inner/conventional tongue portion as taught by Dassler in the shoe of Gatti as modified above to alleviate painful pressure exerted by the lacing on the wearer's foot.

In reference to claim 6, Gatti as modified above discloses the claimed invention except for the exact materials for the padding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam with the properties as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Voss (830753).

Gatti as modified above shows a shoe substantially as claimed except for the exact inner tongue portion. Voss teaches the use of an elastic for an inner tongue portion (6). It would have been obvious to use elastic material for the inner tongue portion as taught by Voss in the shoe of Gatti as modified above to provide a tight get adjustable fit.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 3-26, and 28 are rejected under the judicially created doctrine of double patenting over claims 1-21 of U. S. Patent No. 6,408,542 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim shoes with inner and outer tongues, padding and fastening and engagements structures.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

10. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,408,542 in view of Sass (3650051).

Patent '542 claims a shoe substantially as claimed except for the exact location of the attachment of the outer tongue. Sass teaches attaching an outer tongue on the side of the shoe. It would have been obvious to attach the outer tongue portion on the side as taught by Sass in the shoe claimed in Patent '542 to provide a more secure permanent attachment of the outer tongue portion.

11. Claim 27 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,408,542 in view of Voss (830753).

Patent '542 claims a shoe substantially as claimed except for the exact inner tongue portion. Voss teaches the use of an elastic for an inner tongue portion (6). It would have been obvious to use elastic material for the inner tongue portion as taught by Voss in the shoe claimed in Patent '542 to provide a tight get adjustable fit.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).



Art Unit: 3728

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a long horizontal flourish extending to the right.

Marie Patterson  
Primary Examiner  
Art Unit 3728